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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,365	06/10/1998	TAKESHI KAKINUMA	163852016000	9569

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MORRISON & FOERSTER LLP  
1650 TYSONS BOULEVARD  
SUITE 300  
MCLEAN, VA 22102

EXAMINER

GRAY, LINDA LAMEY

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/095,365

Applicant(s)

KAKINUMA ET AL.

Examiner

Linda L Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Request for Continued Examination**

**1.** A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 6-3-02 has been entered.

**Claim Rejections - 35 USC § 102**

**2.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**3.** The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**4. Claims 1-2, 5, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Norman, Jr. et al. (US 5,807,457).**

**Claims 1 and 14,** Norman, Jr. et al. (Norman et al.) teach a sheet sorting apparatus for adhering a marker 132 to predetermined sheet 22 including

**(a)** a tape feeder for pulling out tape 194 having heat/pressure sensitive adhesive 134 on one side edge where feeder includes a pair of feed rollers 196 and 198,

**(b)** cutter 224 for making marker 132 by cutting tape 194 at a preset length when the tape feeder is operated synchronously therewith,

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(c) guide 74/106 for positioning marker 132 to a predetermined position on sheet 22, and

(d) a marker-and-sheet-feeder for feeding marker 132 and sheet 22 in partially overlapping position wherein marker 132 is adhered to sheet 22 by a predetermined pressure force (caused by rollers 150 and 73) as they pass through the marker-and-sheet-feeder.

Marker 132 and sheet 22 are moved through the marker-and-sheet feeder at the same time, and the feeding is continuous for each individual sheet 22 and associated marker 132.

Rollers 150 and 73 are in contact with each other when marker 132 is adhered to sheet 22 and separate from each other when sheet 22 not receiving marker 132 are fed, and such occurs when the apparatus is in mode 302 (c 4, L 26 to c 13, L 8).

**Claim 2**, marker 132 is adhered to an underside of sheet 22 in that marker 132.  
**Claim 5**, the apparatus includes marker detector 256 in a forward position of the apparatus.

**Claim Rejections - 35 USC § 103**

**5.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**6. Claims 3 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. in view of Cavender (US 4,070,220).**

**Claim 3**, Norman et al. teach character marker printer 80 for applying a predetermined character pattern to marker 132.

**Claim 3**, Norman et al. do not teach a printer controller for determining the character to print on marker 132 so that the same character is printed on each marker 132.

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It is conventional to provide a printer with a printer controller to apply the same indicia pattern to labels where the labels can be mass produced. This is also demonstrated by Cavender.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. a printer controller to apply the same indicia to markers 132 because it is conventional to provide such for labels to apply the same indicia pattern to the labels so that the labels can be mass produced.

***Claims 9-10, Norman et al. do not teach an inkjet printer (claim 9) or stamper (claim 10).***

An ink jet printer and a stamper are conventional in the art.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. an inkjet printer or stamper because an inkjet printer and a stamper are conventional printers, and it is obvious to replace one type of printer (that of Norman et al. not specifically disclosed) with another art recognized alternative printer.

**7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. in view of Lowe et al. (US 3,926,713).**

***Claim 4, Norman et al. do not means for changing the adhering position of marker 132 on sheet 22.***

Lowe et al. teach that changing the position of a marker of a sheet is possible using solenoids 40, 41, and 42 so that one can place marker 53 as desired or necessary (c 2, L 23, to c 10, L 51).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. means for changing the adhering

position of marker 132 and sheet 22 because Lowe et al. teach making the adhering position of a tab possible gives one the freedom of placing the marker as desired or necessary.

**8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. in view of Nobile et al. (US 5,390,594).**

*Claim 6, Norman et al. do not teach a tape end detector on the path of tape 194 for signaling tape exchange.*

Nobile et al. teaches the necessity of a tape end detector on the path of a tape for signaling tape exchange so that the machine operating on the tape does not continue to operate unnecessarily. Detector 216 performs this operation (c 1, L 49-52; c 2, L 34-43; c 3, L 35-58; c 11, L 13, to c 12, L 29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. a tape end detector on the path of tape 194 for signaling tape exchange because Nobile et al. teaches the necessity of having a tape end detector on the path of a tape for signaling tape exchange so that the machine operating on the tape does not continue to operate unnecessarily.

**9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. in view of Nobile et al. (US 5,390,594).**

*Claims 7-8, Norman et al. do not teach a single external motor for driving the tape feeder, cutter 224, guide 74/106, and the marker-and-sheet-feeder.*

It is conventional to use one external motor to operate several items of an apparatus in order to save on the cost of purchasing more than one motor.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman a single motor for driving the tape feeder, cutter 224, guide 74/106, and the marker-and-sheet-feeder in order to save on the cost of purchasing more than one motor.

**10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. in view of Applicants' admitted prior art.**

**Claim 12**, the above discussion of Norma et al. applies herein. Also, Norman et al. teach using the sheet sorting apparatus in combination with an image processing apparatus at column 1, line 12, to column 2, line 15. Sheets 22 are manually placed in holder 34 for feeding to the apparatus.

***Claim 12, Norman et al. do not teach that the image processing apparatus feeds sheets 22 to the sheet sorting apparatus.***

However, Applicants' admitted prior art (AAPA) teaches that it is conventional for an imaging processing apparatus to include a sheet sorting apparatus where the image processing apparatus feeds the sheets to the sheet sorting apparatus. The sheets are then placed on a tray (pg 1, L 9, to p 2, L 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. that the image processing apparatus feeds sheets 22 to the sheet sorting apparatus because AAPA teaches that it is convention to provide an imaging processing apparatus in combination with a sheet sorting apparatus that feeds the sheets to the sheet sorting apparatus where such a combination in Norman et al. would eliminate the manual labor of collecting sheets 22 from the image processing apparatus and placing sheets 22 manually into holder 34.

***Claim 13, Norman et al. modified do not teach that at least one side of the tray is lower than the middle of the tray (i.e., tilted).***

It is conventional to provide a tilted tray for receiving sheets from a sheet sorting apparatus because tilted trays aid in lining up the sheets correctly along a given side.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Norman et al. modified that at least one side of the tray is lower than the middle of the tray (i.e., tilted) because it is conventional to provide a tilted tray for receiving sheets from a sheet sorting apparatus because tilted trays aid in lining up the sheets correctly along a given side.

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**Response to Arguments**

**11.** Applicants' comments of 6-3-03 have been fully considered but are considered moot in view of the new grounds of rejection necessitated by amendment.

**Conclusion**

**12.** Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703) 308-1093, Monday-Friday from 6:30 am to 3:30 pm. The necessary fax numbers are (703) 872-9310 and (703) 872-9311.

llg

August 11, 2003

*Linda L. Gray*  
LINDA GRAY  
PRIMARY EXAMINER